

ESTTA Tracking number: **ESTTA29229**

Filing date: **03/28/2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91164226
Party	Defendant EATON LEONARD ROBOLIX, INC. EATON LEONARD ROBOLIX, INC. Suite A 1391 Specialty Drive Vista, CA 92083
Correspondence Address	ANNEMARIE KAISER KNOBBE MARTENS OLSON & BEAR, LLP 2040 MAIN ST FL 14 IRVINE, CA 92614-7216
Submission	Answer
Filer's Name	Frederick S. Berretta
Filer's e-mail	efilings@kmob.com
Signature	Frederick/S/Berretta
Date	03/28/2005
Attachments	Answer to Opp ERIX.005M.pdf (5 pages)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of:

EAGLE PRECISION TECHNOLOGIES, INC.,

Opposer,

v.

EATON LEONARD ROBOLIX, INC.,

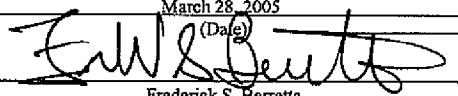
Applicant.

) Opposition No.: 91164226

) Mark: EATON LEONARD

) Serial No.: 78/462,208

) I hereby certify that this correspondence and all marked
) attachments are being transmitted by electronic mail to
) the United States Patent and Trademark Office at
) <http://www.uspto.gov> on

) March 28, 2005
) (Date)
) 
) Frederick S. Berretta

ANSWER TO OPPOSITION

Box TTAB/FEE
 Assistant Commissioner for Trademarks
 2900 Crystal Drive
 Arlington, VA 22202-3513

Dear Sir:

Applicant EATON LEONARD ROBOLIX, INC. ("Applicant") hereby answers the opposition filed by EAGLE PRECISION TECHNOLOGIES, INC ("Eagle") with respect to the application for the mark EATON LEONARD, Serial No.: 78/462,208, as follows:

1. Applicant admits that it is and has been engaged in the business of manufacture, sale, service and repair of tube bending machines and equipment for measurement of tubes formed by tube bending machines, and is a competitor of Eagle. Except as expressly admitted above, Applicant denies the allegations of paragraph 1 of the Opposition.

2. Applicant admits that its predecessor in title (Eaton Leonard, Inc. or "ELI") and Applicant have used the mark EATON LEONARD since at least as early as August 19, 1974 in connection with automatic tube bending machines in International Class 7, and since at least as early as December 17, 1974, in interstate commerce. Applicant also admits that Applicant and its predecessor in title have used the mark EATON LEONARD since at least as early as November 6, 1973 in connection with measuring instruments for bent tubes and surfaces and for computing and printing data therefore in International Class 9, and since at least as early as December 12, 1973, in interstate commerce. Applicant also admits that Applicant and its predecessor in title have used the mark EATON LEONARD since at least as early as December 17, 1974 in connection with repair and maintenance of automatic tube bending machines. Except as expressly admitted above, Applicant denies the allegations of paragraph 2 of the Opposition, and specifically denies that ELI is still a subsidiary of Eagle.

3. Applicant admits that Eagle acquired ELI sometime in 1997. Except as expressly admitted above, Applicant denies the allegations of paragraph 3 of the Opposition, and specifically denies that Eagle ever obtained the common law rights to the EATON LEONARD trademark.

4. Applicant admits that, for a period of time, Eagle used the mark EAGLE EATON LEONARD in connection with certain goods and services, but then abandoned the mark in 2000. Except as expressly admitted above, Applicant denies the allegations of paragraph 4 of the Opposition.

5. Applicant admits that, for a period of time, Eagle used the mark EAGLE EATON LEONARD with a design in connection with certain goods and services, but then abandoned the mark in 2000. Except as expressly admitted above, Applicant denies the allegations of paragraph 5 of the Opposition.

6. Applicant admits the allegations of paragraph 6 of the Opposition.

7. Applicant admits the allegations of paragraph 7 of the Opposition.

8. Applicant admits the allegations of paragraph 8 of the Opposition.

9. Applicant admits that the EATON LEONARD trademark is famous in the tube bending industry and has acquired great value as an identifier of Applicant's goods. Except as expressly admitted above, Applicant denies the allegations of paragraph 9 of the Opposition.

10. Applicant admits that in or about May 2000, Applicant was formed as a result of a transaction between Eagle and its creditors/bankers, ELI, and Financiere Robolix S.A.R.L. Except as expressly admitted above, Applicant denies the allegations of paragraph 10 of the Opposition.

11. Applicant admits filing trademark applications for the marks EATON LEONARD and EATON LEONARD with design (the "Eaton Leonard logo") and that Applicant's ownership rights in the marks is an issue in a pending action in the United States District Court for the Southern District. Except as expressly admitted above, Applicant denies the allegations of paragraph 11 of the Opposition.

12. Applicant denies the allegations of paragraph 12 of the Opposition.

FIRST AFFIRMATIVE DEFENSE

13. The Opposition fails to state facts sufficient to oppose the application of Applicant for the mark EATON LEONARD.

SECOND AFFIRMATIVE DEFENSE

14. The Opposition is barred by reason of the Opposer's intentional and unintentional abandonment of the EATON LEONARD trademark.

THIRD AFFIRMATIVE DEFENSE

15. The Opposition is barred by reason of Opposer's unclean hands with respect to Applicant.

FOURTH AFFIRMATIVE DEFENSE

16. The Opposition is barred by reason of Opposer's contractual, legal and equitable estoppel.

FIFTH AFFIRMATIVE DEFENSE

17. The Opposition is barred by reason of Opposer's acquiescence in Applicant's ownership and exclusive use of the EATON LEONARD trademark.

SIXTH AFFIRMATIVE DEFENSE

18. Opposer has no ownership rights in the EATON LEONARD trademark and lacks standing to oppose the present application.

SEVENTH AFFIRMATIVE DEFENSE

19. The Opposition fails because Applicant owns the common law rights to the EATON LEONARD trademark and the Eaton Leonard logo.

WHEREFORE, Applicant prays that the Opposition be ruled in favor of Applicant, and that registration be allowed to issue on Application Serial No. 78/462,208.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: March 28, 2005

By: 

Frederick S. Berretta (Reg. No. 38,004)
James F. Herkenhoff (Reg. No. 51,241)
550 West C Street, Suite 1200
San Diego, CA 92101
(619) 235-8550
Attorneys for Applicant
Eaton Leonard Robolix, Inc.

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **ANSWER TO OPPOSITION** upon Opposer's counsel by placing it in a sealed envelope, via First Class Mail, postage prepaid, on March 28, 2005, addressed as follows:

Frank D. Hobbs, Esq.
Olivia Goodkin, Esq.
RUTTER HOBBS & DAVIDOFF
1901 Avenue of the Stars, Suite 1700
Los Angeles, CA 90067-6018
310-286-1700
310-286-1728 (FAX)
Attorney for Eagle Precision, et al.


Kera A. Harkins